UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,059	09/25/2003	Kyle N. Patrick	CA920020057US1	5839

46073 7590 04/27/2007		EXAMINER
IBM CORPORATION (VE)		KEEFER, MICHAEL E
C/O VOLEL EMILE		

ART UNIT	PAPER NUMBER
2109	

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SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

		Application No.	Applicant(s)
Office Action Summary		10/671,059	PATRICK, KYLE N.
		Examiner	Art Unit	
		Michael E. Keefer	2109	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *16 April 2007*.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-30* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-30* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All   b) ☐ Some * c) ☐ None of:

       1. ☐ Certified copies of the priority documents have been received.

       2. ☐ Certified copies of the priority documents have been received in Application No. _____.

       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   This Office Action is responsive to the Amendment filed 4/16/2007.

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding **claim 11**, which is drawn to "a computer program product". In order for a claim to be statutory it must be drawn to a process, article of manufacture, composition of matter, or machine. In accordance with Applicant's specification "a computer usable medium" may include "a computer readable modulated carrier signal". (Page 5, paragraph 2) This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Instead, it includes a form of energy. Energy does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

Claims 12-20 do not remove any non-statutory matter from the claim, therefore are rejected for the same.

Regarding claim 21, which is drawn to an article comprising a modulated carrier signal. Applicant's specification on page 5 in paragraph 2 states, "The invention may also be embodied on a computer readable modulated carrier signal." This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Instead, it includes a form of energy. Energy does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

Claims 22-30 do not remove the non-statutory subject matter from the claim and therefore are rejected for the same.

In addition, **claim 21** is directed merely to functional descriptive material as stated in applicant's specification on page 5 in paragraph 2, "[The present invention] may also be embodied as ... computer software code ..." This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Instead, it includes functional descriptive material. Functional descriptive material does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and

constitute a manufacture, and not a composition of two or more substances to constitute

a composition of matter.

Claims 22-30 do not remove the non-statutory subject matter from the claim and

therefore are rejected for the same.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.   Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Hara

(US 5938725).

Regarding **claim 1**, Hara discloses:

A method of selecting recipients of an e-mail message for transmission by a

recipient computer in reply to a received e-mail message, the received e-mail message

including a chain of previously sent e-mail messages wherein each previously sent e-

mail message includes at least one previous sender and one previous recipient, the

method comprising:

i) storing said received e-mail message in the memory of said recipient computer;

(storage means for storing therein a received electronic mail Col 2. lines 58-59)

ii) parsing the contents of the said received email for e-mail addresses of the

previous senders and recipients to form and forming a list of said parsed e-mail

addresses; (extracting means for extracting a mail address contained in the electronic

mail Col. 2 lines 64-65, it is inherent that previous senders of a chain email are also previous receivers)

iii) displaying said list of parsed e-mail addresses; (Col 4 Lines 2-8, "outputted as the transmission destination candidates") and

selecting, by the e-mail recipient, one or more of the e-mail addresses from the list to address the e-mail message, each selected e-mail address identifying a user to which the e-mail message is to be sent; and

iv) forming a reply e-mail message to recipients selected from said list by said user. (Col 4 lines 8-11 "the user can readily transmit the electronic mail by merely selecting his desired transmission destination from these outputted transmission destination candidates.)

Regarding **claim 3 and as applied to claim 1** Hara discloses:

wherein said list of parsed e-mail addresses is displayed in response to an action by a user. (Col 3, lines 4-9, the user inputting a keyword from an input device starts the process of extraction.)

4.   Claims 1-3, 5-6, 11-13, 15-16, 21-23, and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Birrell et al. (US 6189026 B1) hereafter Birrell.

Regarding **claims 1, 11, and 21**, Birrell discloses:

A method of selecting recipients of an e-mail message for transmission by a recipient computer in reply to a received e-mail message, the received e-mail message including a chain of previously sent e-mail messages wherein each previously sent e-

mail message includes at least one previous sender and one previous recipient, the

method comprising:

i) storing said received e-mail message in the memory of said recipient computer;

("Mail messages are stored in message files of the mail service system" Abstract)

ii) parsing the contents of the said received email for e-mail addresses of the

previous senders and recipients to form and forming a list of said parsed e-mail

addresses;; (Col 12, lines 16-18 "the system heuristically locates text strings which

have the syntax of email addresses", it is inherent that previous senders of a chain

email are also previous receivers)

iii) displaying said list of parsed e-mail addresses; (Col 12 lines 18-19 "if the user

clicks on one of these addresses, inherently the list of addresses must be displayed in

order for a user to click on them) and

selecting, by the e-mail recipient, one or more of the e-mail addresses from the

list to address the e-mail message, each selected e-mail address identifying a user to

which the e-mail message is to be sent; and

iv) forming a reply e-mail message to recipients selected from said list by said user. (Col

12 lines 18-21 "If a user clicks on one of these addresses then the system will display a

composition window so that the user can easily generate a reply message to the

selected email address(es).)

Birrell discloses that his method can be computer implemented, therefore must

be able to be implemented on a computer readable media as recited in claim 11 or a

computer readable carrier wave as recited by claim 21.

Regarding **claims 2, 12, and 22 and as applied to claims 1, 11, and 21**, Birrell discloses:

wherein said received e-mail message is a multi-party e-mail. (The reply to all function described in Col 14 lines 36-38 clearly shows that emails with multiple parties are included by the disclosed email system.)

Regarding **claims 3, 13, and 23 and as applied to claims 1, 11, and 21**, Birrell discloses:

wherein said list of parsed e-mail addresses is displayed in response to an action by a user. (Col 12, lines 16-17 disclose that "When displaying retrieved messages" and choosing to display a message is a user action.)

Regarding **claim 5, 15, and 25 and as applied to claims 1, 11, and 21**, Birrell discloses:

wherein said recipient computer parses said received e-mail message automatically prior to said user action. (Col. 7 lines 23-24 state that messages are processed in batches as they are received.)

Regarding **claim 6, 16, and 26 and as applied to claims 1, 11, and 21**, Birrell discloses:

wherein said recipient computer parses said received e-mail message automatically upon receipt of said message. (Col. 7 lines 23-24 state that messages are processed in batches as they are received.)

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6.   Claims 1-4, 7-10, 11-14, 17-20, 21-24, 27-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Ullmann et al. (US 7103634 B1) hereafter Ullmann.

Regarding **claims 1, 11, and 21**, Ullmann discloses:

A method of selecting recipients of an e-mail message for transmission by a recipient computer in reply to a received e-mail message, the received e-mail message including a chain of previously sent e-mail messages wherein each previously sent e-mail message includes at least one previous sender and one previous recipient, the method comprising:

i) storing said received e-mail message in the memory of said recipient computer; (this step is inherent as the message must be stored in memory of the computer)

ii) parsing the contents of the said received email for e-mail addresses of the previous senders and recipients to form and forming a list of said parsed e-mail addresses;; (Col 8 lines 55-57 "scanning the attached or inline header fields of the original message", it is inherent that the parsed email addresses will comprise both the previous senders and recipients if the inline header fields are all parsed.)

iii) displaying said list of parsed e-mail addresses; (the "special field" disclosed in line 54 would display the results of the scanning above) and

selecting, by the e-mail recipient, one or more of the e-mail addresses from the

list to address the e-mail message, each selected e-mail address identifying a user to

which the e-mail message is to be sent; and

iv) forming a reply e-mail message to recipients selected from said list by said

user. (Figure 4 step 47 of fully incorporated application 09/672,181 shows that the built

list of previous senders and recipients can be used to provide automatic addressing for

a reply or forwarded message.)

Ullmann discloses that his method can be computer implemented, therefore must

be able to be implemented on a computer readable media as recited in claim 11 or a

computer readable carrier wave as recited by claim 21.

Regarding **claims 2, 12, and 22 and as applied to claims 1, 11, and 21**,

Ullmann discloses:

wherein said received e-mail message is a multi-party e-mail. (Ullmann

specifically discloses that chain messages (i.e. multi-party emails) are processed using

his method, "An enhanced e-mail reader and composer having automatic addressing

functions to create and manage chain groups for organizing chain-forwarded and chain-

replied messages" abstract.)

Regarding **claims 3, 13, and 23 and as applied to claims 1, 11, and 21**,

Ullmann discloses:

wherein said list of parsed e-mail addresses is displayed in response to an action

by a user. (Fig. 4 of fully incorporated application 09/672,181 where the step of opening

and displaying an email is directly followed by the scanning of the email, therefore the act of the user opening the email causes the scanning.)

Regarding **claims 4, 14, and 24 and as applied to claims 1, 3, 11, 13, 21, and 23**, Ullmann discloses:

wherein said user action comprises initiating a reply message. (Col 10, lines 21-42, where it is described that after a reply message is started a list of possible recipients, "one or more found previous recipients and originators" in lines 34-35)

Regarding **claims 7, 17, and 27 and as applied to claims 1, 11, and 21**, Ullmann discloses:

wherein said recipient computer loads and displays said received email for viewing by said user prior to said parsing step. (In fully incorporated application 09/672181, Col. 6 lines 14-16 states that first the message is opened and displayed, then it is scanned.)

Regarding **claims 8, 18, and 28 and as applied to claims 1, 11, and 21**, Ullmann discloses:

wherein prior to said parsing step said user requests a list of potential reply e-mail addresses. (Col 10, when the user asks to make a reply message, the message is parsed in order to find possible reply candidates as inherently part of forming a reply requires a user to specify to whom the message is going to.

Regarding **claims 9, 19, and 29 and as applied to claims 1, 11, and 21**, Ullmann discloses:

wherein said response message is formed by auto-populating SMTP headers

with said list of e-mail addresses (Col. 9 lines 18-22 disclose populating the reply-to field

of the email automatically with the addresses found in the search of the email.)

Regarding **claims 10, 20, and 30 and as applied to claims 1, 11, and 21,**

Ullmann discloses:

wherein said response message is formed by auto-populating user interface

graphical elements. (Col 10 lines 29-36 describes that the user is prompted to create an

address book entry for a group, in which the group is automatically filled with addresses

found in the search of the email.)

Response to Arguments

7.   Applicant's arguments filed 4/16/2007 have been fully considered but they are

not persuasive.

Summary of Arguments

1) Applicant requests that the objections to the claims be withdrawn.

2) Applicant requests that the 35 U.S.C. 112 rejections be withdrawn.

3) Applicant requests that the 35 U.S.C. 101 rejections be withdrawn.

4) Applicant requests that the non-statutory double patenting rejections be withdrawn.

5) Applicant requests that the 35 U.S.C. 102(b) rejection of the claims involving Hara,

Birell, and Ullmann be withdrawn and argues that these references do not teach the

newly added claim limitations.

Response to Arguments

1) The examiner withdraws the objections to the claims, so Applicant's arguments are moot.

2) The examiner withdraws the 35 U.S.C. 112 2nd paragraph rejections, so Applicant's arguments are moot.

3) The examiner withdraws the rejection of claims 1-10 under 35 U.S.C. 101, but maintains the rejections of claims 11-30 for the previously stated grounds.

4) The examiner withdraws the rejection of claims 1, 9, 11, and 19 on the ground of non-statutory obvious-type double patenting, so Applicant's arguments are moot.

5) The examiner has considered applicants arguments regarding the rejection of claims 1, 11, and 21, but does not find them persuasive. The new limitations have been added to the rejection of these claims above, but the examiner does not believe that they overcome the rejection because all three references disclose the process of parsing an email to retrieve email addresses from within the email, whether from inline header fields or the body text of the email. These email addresses would include both previous senders (the From: field in inline headers) and previous recipients (the CC: field in inline headers); it is also inherent that previous senders of a chain email must have also received the email at some point in order to forward it to someone else, thus they are also previous receivers.

Conclusion

8.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Michael E. Keefer whose telephone number is (571)

270-1591. The examiner can normally be reached on Monday-Thursday 8am-5pm,
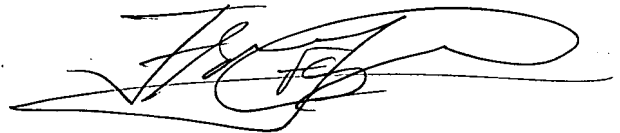
second Fridays 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Frantz Jules can be reached on (571) 270-1808. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MEK 4/24/2007

FRANTZ JULES
SUPERVISORY PATENT EXAMINER